

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Soley Bjornsdottir, Augustine Kong and Thorgeir E. Thorgeirsson

Application No.: 10/571,865 Group: 1634

Filed (371(c)): March 14, 2006 Examiner: S.T. Kapushoc

Confirmation No.: 6960

For: INVERSION ON CHROMOSOME 8P23 IS A RISK FACTOR FOR
ANXIETY DISORDERS, DEPRESSION AND BIPOLAR DISORDERS



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REPLY TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Office Communication dated July 23, 2008, and the Restriction Requirement dated March 4, 2008, the claims of Group 1 (Claims 56-69), drawn to a method of diagnosing a psychiatric disorder, are elected for prosecution. Applicants reserve the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicants do not hereby abandon or waive any rights in the non-elected inventions.

Applicants provisionally elect genetic marker SG08S71 and marker DG00AAHBG as the species for searching purposes. Claims readable on the elected species are 56-68.

Applicants traversal of the lack of unity of invention restriction requirement is set forth below.

Lack of Unity Restriction Requirement

The pending claims are subject to a three way restriction requirement as the examiner finds the claims are not so linked as to form a single general inventive concept under PCT Rule 13.1. It is respectfully noted that the instant application is the US national stage application of PCT/US04/30699. The PCT found there to be no unity of invention issues raised with the claims. Applicants question how the US PTO can now raise unity of invention issues at this stage when the PCT, well versed in the unity rules, did not raise this during the PCT stage. Moreover, the PCT did not find there to be any unity issues among claims drawn to methods of diagnosis, kits and method for predicting the efficacy of a drug. Applicants believe that all pending claims should be examined in accordance with the PCT determination that there were no unity issues raised. Indeed, the unifying concept is Applicants' discovery that the orientation of Inv8p23 is indicative of susceptibility to a psychiatric disorder or comorbid disorder. The markers or combination of markers or haplotypes represent various tools that the scientist can use to detect the orientation of Inv8p23, where the orientation is indicative of a psychiatric disorder or comorbid disorder. Therefore, Applicants respectfully request that Groups 2 and 3 be examined together with the elected claims of Group 1.

The Examiner has required election of a single specific combination of markers, as stated in the Official Communication (i.e., "a single specific combination of the genetic markers is required"). It is stated in the Office Action at page 3 that there is no common or special technical feature that joins the different markers and combinations thereof, and Applicants are unclear as to whether the requirement for selection of a single specific combination of markers is a species election. Applicants note that the Specification and claims support a single marker (see, e.g., Claim 62, "one or more markers"), and request clarification of the need for election of a combination of markers.

Applicants understand the requirement of selection of a combination of markers to be a species election where the non-elected species will be examined if the provisionally elected species is found patentable. If the election is not a species election, Applicants respectfully note that the restriction requirement for lack of unity is improper for all of the reasons presented above. In view of a clear unifying concept present in all of the pending claims, the lack of unity restriction requirement should be respectfully withdrawn.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Alice Connell 33542 for
Elizabeth W. Mata
Registration No. 38,236
Telephone: (978) 341-0036
Facsimile: (978) 341-0136

Concord, MA 01742-9133

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